

REMARKS

This Amendment is filed in response to the Office Action dated December 15, 2004. For the following reasons this application should be allowed and the case passed to issue. No new matter is introduced by this amendment. The amendments to claims 1, 8, and 9 are supported by the written description and Figures, and further clarify the claims.

Claims 1-13 are pending in this application. Claims 1, 2, 5, and 7-11 are rejected. Claims 1, 8, and 9 have been amended in this response. Claims 3, 4, 6, 12, and 13 were objected to.

Claim Rejections Under 35 USC § 102

Claims 1, 2, 5, and 7-11 were rejected under 35 USC § 102(e) as being anticipated by Matsuyama et al. (U.S. Patent No. 6,585,430). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the instant invention as claimed and the cited prior art.

An aspect of this invention, per claim 1, is a substrate holding device for holding a substrate comprising a holding member having an atmosphere flow passage for holding the substrate. A suction pipe sucks an atmosphere through the atmosphere flow passage and a supply pipe supplies a predetermined gas to the atmosphere flow passage. The predetermined gas is supplied through the supply pipe while the atmosphere is sucked through the suction pipe thereby to release the substrate from the holding member.

Another aspect of this invention, per claim 8, is a substrate processing apparatus for performing a predetermined process on a substrate comprising a substrate holding device. The substrate holding device includes a holding member having an atmosphere flow passage for holding the substrate, a suction pipe for sucking an atmosphere through the atmosphere flow

passage, and a supply pipe for supplying a predetermined gas to the atmosphere flow passage. The predetermined gas is supplied through the supply pipe while the atmosphere is sucked through the suction pipe, thereby to release the substrate from the holding member. The processing apparatus further comprises a processing unit for performing the predetermined process on the substrate held by the substrate holding device.

Another aspect of this invention, per claim 9, is a method of releasing a substrate in a substrate holding device for holding a substrate under suction using a holding member. The method comprises the steps of sucking an atmosphere through a suction pipe from an atmosphere flow passage provided to the holding member. The substrate is held using the holding member. A predetermined gas is supplied through a supply pipe toward the atmosphere flow passage. In a state in which the step of sucking an atmosphere through a suction pipe continues, the substrate held in the step of holding a substrate is released. The step of releasing the held substrate is triggered by the step of supplying a predetermined gas through the supply pipe.

The Examiner asserted that Matsuyama et al. disclose a substrate processing apparatus comprising a substrate holding device 275, holding member 276, suction pipe 278, gas supply 269, and a processing unit.

Contrary to the Examiner's assertion, Matsuyama et al. do not disclose the claimed substrate holding device, substrate processing apparatus, or method of releasing a substrate. When a substrate is to be released in Matsuyama et al., the gas supply unit 269 first starts to supply a gas to restore the pressure in the first route 260 to P1 (col. 17, lines 12-17). However, the gas supplied from supply unit 269 is not supplied from the mounting board 275 (Fig. 15). The atmosphere flow paths (suction ports 277) are for suction only and do not supply a gas to release the substrate from the holding member, as required by the present invention.

Further, when the substrate W is to be released from the mounting board 275, the suction through the suction ports 277 is first stopped before the substrate W is released by raising and lowering pins 283 (col. 17, lines 18-21). Thus, the system of Matsuyama et al. does not release the substrate while the atmosphere is sucked, as required by claims 1, 8, and 9.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 399, 36 USPQ2d 1101 (Fed. Cir. 1995); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). Because Matsuyama et al. do not disclose supplying a gas to release the substrate from the holding member, and releasing the substrate while the atmosphere is sucked, as required by the present invention, Matsuyama et al. do not anticipate claims 1, 8, and 9.

Applicant further submits that Matsuyama et al. do not suggest the claimed substrate holding device, substrate processing apparatus, or method of releasing a substrate.

The dependent claims are allowable for at least the same reasons as the independent claims from which they depend, and further distinguish the claimed invention.

Allowable Subject Matter

Claim 3, 4, 6, 12, and 13 are objected as being dependent upon a rejected base claim but would be allowable if rewritten in independent form.

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Applicant gratefully acknowledges the indication of allowable subject matter. Because independent claims 1, 8, and 9 are believed to be allowable for the reasons discussed above, it is not believed to be necessary to further amend the claims.

In light of the above Amendments and Remarks, this application should be allowed and the case passed to issue. If there are any questions regarding these remarks or the application in general, a telephone call to the undersigned would be appreciated to expedite prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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